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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,480	11/25/2003	Jeffrey Breslow	06181-062001	4363

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FISH & RICHARDSON P.C.  
 1425 K STREET, N.W.  
 11TH FLOOR  
 WASHINGTON, DC 20005-3500

EXAMINER

CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,480

Applicant(s)

BRESLOW ET AL.

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-14,16 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-14,16 and 21-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2, 8-11 and 21-23, 29, 31, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolwicz and Kelly as applied in the previous Office action in view of U.S. Patent Number 5,031,919 (Dixon).

Regarding claims 1, 2, 8-11, 29, 35 and 36, Figure 1 of Kolwicz shows that a playing piece is inherently capable of being bounced into one of the target sections. Regarding the table-top play of the game, Kolwicz discloses that his game can be played indoors or outdoors, and is applicable for home use as well as for commercial use but does not explicitly describe table-top use. See column 1, lines 21-27. However, it would have been obvious to one of ordinary skill in the night to size the Kolwicz game for table-top play in view of Dixon who teaches that it is old and well-known in the arcade game art to miniaturize traditional arcade games to allow for game portability and home use. See Dixon at column 1, lines 5-22 and 41-47.

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Regarding new claims 21-23, Kelly teaches that it is old and well-known in the gaming art to provide different game modes in game machines for player variety. See column 4, lines 28-34. Applicant has done no more than to select features from the prior art and incorporate them into a unitary feature without materially altering the structure or function of each individual feature and without producing any new or unexpected result. To select features from the prior art to effect results expected from these features is within the purview of 35 USC 103.

With further regard to claim 29, Dixon shows that it is old and well-known in the gaming art to collect the playing pieces in a single holding area after they pass through the target apertures. See track 16 in Figure 1.

Regarding claim 31, Kelly teaches that it is old and well-known in the gaming art to provide different game modes in game machines for player variety. See column 4, lines 28-34.

3. Claims 3-5, 7, 12-14, 16, 24, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolwicz and Kelly in view of Dixon as applied above in view of Johns as applied in the previous Office action.

4. Claims 26-28 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolwicz and Kelly in view of Dixon as

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applied above in view of U.S. Patent Number 5,697,611 (Kelly et al., hereinafter Kelly '611).

Regarding claims 26-28 and 32-34, it would have been obvious to one of ordinary skill in the art to provide the recited game modes in the Kolwicz game as modified above in view of Kelly '611 who teaches that it is old and well-known in the gaming art to provide time limits to achieve certain goals or opportunities to achieve certain goals multiple times. See column 3, lines 30-42. Again, applicant has done no more than to select features from the prior art and incorporate them into a unitary feature without materially altering the structure or function of each individual feature and without producing any new or unexpected result. To select features from the prior art to effect results expected from these features is within the purview of 35 USC 103.

#### **Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (571) 272-4415.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Raleigh W. Chiu', is positioned above the printed name.

Raleigh W. Chiu  
Primary Examiner  
Technology Center 3700

RWC:dei:feif

22 December 2004